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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,540	09/27/2001	Hiroshi Ogino	80398.P460	4648

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JB

<p><i>Office Action Summary</i></p>	Application No. 09/966,540	Applicant(s) OGINO, HIROSHI	
	Examiner Calvin L Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12-16-04</u> . | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-29 have been examined.

Response to Amendments/Arguments

2. Applicant is of the opinion that the prior art does not anticipate or render obvious Applicant's claims because the prior art does not teach Applicant's "privacy server" and does not perform electronic transactions "without providing an identification of a user" of a transaction device. The Examiner respectfully disagrees. In Applicant's analysis of the Buckley et al. system, Applicant correctly notes that

... Buckley is silent on whether the communication with connection server, news server and/or portal server provides or withholds the user's identification. Thus, the connection, news and/or portal servers supply the requested (Remarks, 11-16-04, page 9, lines 17-19)

Therefore, the Examiner and the Applicant are in accordance, as Buckley et al. do not teach, disclose nor suggest revealing a user identification during a transaction (column/line 5/62-6/13). Regarding a "privacy server", the Applicant has not provided a specific definition for such a device and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims (*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057

(Fed. Cir. 1993)). Hence according to Applicant's claims for a server to be a "privacy server", a server need only, withhold user identification during a transaction (e.g. claims 1 and 7), couple to a transaction device for authorizing transactions (e.g. claim 18) couple or comprise a financial institution (e.g. claims 22 and 23), comprise a secure database of transaction device information and user information, said database accessed for authorizing a transaction (e.g. claim 24), and/or perform financial transactions associated with the transaction (e.g. claim 25). As these features are clearly taught by Buckley et al., Walker et al. and Peckover (Buckley et al., figures 4, 5, 8 and 9, column 9, lines 8-64; Walker et al., figures 3A, 5, 9A-B, 11A and 13; Peckover, abstract, figures 1 and 4A), Applicant's claim to a "privacy server" cannot distinguish Applicant's claims from the clear teachings of the prior art.

In response to the 112 Second rejection of claim 7, Applicant states that Applicant is claiming a privacy system that interacts with the claimed electronic transaction device (Remarks, 11-16-04, page 8), however, the preamble of claim 7 is clearly directed to an "electronic transaction device". Therefore, the Examiner maintains the 112 Second rejection because Applicant's claims are not precise, clear, correct, and unambiguous (*In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Therefore, the Examiner maintains the rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 7-13 and 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites, a "privacy system comprising a secure mechanism..." However, claim 7 is dedicated to a transaction device that does not comprise or contain a "privacy system".

Claims 8-13 are also rejected as they depend from claim 7.

Claim 15 recites the limitation "the transaction privacy clearinghouse" in line 2. Claims 16 and 17 recite "the electronic commerce transaction" in line 1. There is insufficient antecedent basis for these limitations in the claims.

Claims 16 and 17 are also rejected as they depend from claim 15.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-11, 13, 14 and 26 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Buckley et al., U.S. Patent No. 6,446,871.

As per claims 1-4, 6-11 and 13 the MPEP (2144) is clear,

while features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of *structure* rather than function alone (*italics added*)

Therefore (claims 1-4 and 6), as Buckley et al. clearly disclose a transaction device (figure 3E; column/line 4/48-5/8) comprising a sensor module (e.g. barcode reader) (column 5, lines 9-37; column 6, lines 12-19) and a communication module (figures 4 and 5), that are configured to receive (e.g. product information) (figure 9; column 8, lines 27-44) and transmit data to servers (figures 4, 5, 8 and 9; column 9, lines 8-64 or inherently DNS, caching, and/or proxy servers), respectively. The device also receives data from servers based on the product identification (figures 4, 5, 8 and 9; column 10, lines 14-65), makes requests to purchase a product without providing an identifier of the user (column/line 5/62-6/13), stores retrieved product data (figure 9; column 10, lines 7-39; column/line 10/55-11/26).

As per claims 7-11, and 13 Buckley et al. teach a transaction device comprising a sensor module (for reading product information from a product tag) (figures 1-3E), wireless module (figures 1-3E; column 4, line 55-61), a communication module (abstract; figures 4 and 5), and a display module for displaying received information (figure 9). Buckley et al. also teach an electronic transaction device that can purchase products from a vendor through a secure mechanism using the wireless and communication module (column/line 5/62-6/13; column 9, lines 7-25).

As per claims 14 and 26, Buckley et al. teach receiving at a transaction device, a signal based on a product tag associated with a product (figures 4, 5, 8 and 9), transmitting the product tag to a product server through a privacy server (figure 4) indicating a request of product information based on the product tag without providing an identity of the user (figures 4 and 5) and receiving product information from the product server (figure 9).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Ausems et al., U.S. Patent No. 6,434,403.

As per claims 5 and 12, Buckley et al. teach a transaction device comprising a data acquisition device and a computer for transmitting acquired data to a site on the internet (figures 4, 5, 8 and 9). However, Buckley et al. do not specifically recite a privacy card, digital wallet, or a privacy card configured to be coupled to a wallet. Ausems et al. teach a portable computer such as a privacy card (column 6, lines 53-59) for transmitting data over the internet (figure 2; column/line 5/65-6/8; column 7, lines 9-20; column/line 7/62-8/6). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al. into the portable device of Ausems et al. ('871, column 11, lines 27-37) in order allow users (e.g. traveling salesman-'871, column 5, lines 62-67) to conduct business while on route to a destination.

8. Claims 15, 17, 18, 20-25, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 in view of Walker et al., U.S. Patent No. 6,163,771.

As per claims 15, 17, 18, 20-25, 27 and 29, Buckley et al. teach a transaction device for making purchases over the internet from a vendor

(column/line 5/62-6/13; column 9, lines 8-25) using a transaction device and a server. However, Buckley et al. do not specifically recite using device identifiers. Walker et al. teach a secure method for making purchases over the internet using a device (privacy card, or digital wallet or privacy card coupled to a digital wallet-'771, abstract, figures 1 and 2) identifier and a user account to communicate with a privacy server comprising a database for authorizing a transaction, and wherein the user identity is unknown to a seller (figures 3A-B, 8 and 9B; column/line 6/60-7/20; column/line 7/45-8/65). Walker et al. also teach a privacy server coupled to, or comprising a financial institution (figure 4). Therefore, it would have been obvious to combine the teachings of Buckley et al. and Walker et al. in order to protect a user from credit card theft ('771, column 2, lines 35-61).

9. Claims 16, 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al., U.S. Patent No. 6,446,871 and Walker et al., U.S. Patent No. 6,163,771 as applied to claim 15 above, and in further view of Peckover, U.S. Patent No. 6,119,101.

As per claims 16, 19, and 28 Buckley et al. teach purchases over the internet using product tag data (figures 4, 5, 8 and 9; column/line 5/62-6/13; column 9, lines 8-25). Walker et al. teach secure transaction over the internet using device identifiers (abstract). However, neither Buckley et al. nor Walker et

al. teach receiving coupons. To one of ordinary skill a coupon is a form of advertisement. Peckover teaches a system where users, whose specific identity is unknown to the vendor (figure 4A), make queries regarding desired products and or information (column 15, lines 10-63; column/line 27/51-29/57) are able to receive digital advertisements and other messages from sellers through a third party device (e.g. privacy server) (abstract; figure 1). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Buckley et al., Walker et al. and Peckover in order to allow vendors to target specific advertisements to desired users ('101, abstract; column/line 35/63-37/40)

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

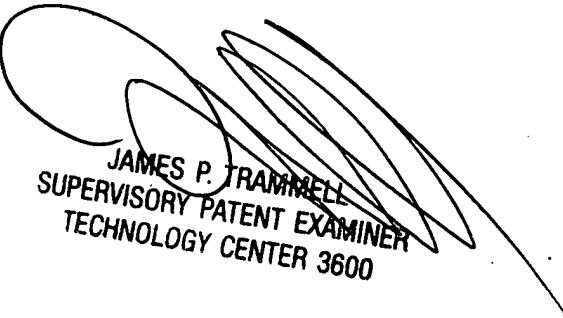
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

February 18, 2005



JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600